

Request for Reconsideration dated October 12, 2004  
Office Action dated 07/13/2004

Application No. 09/916,132

### REMARKS

Claims 1-15 are pending with this Office Action. Claims 1-14 are rejected by this Office Action. The Applicant is adding claim 15.

This Office Action is Made Final. However, the Applicants argue against the finality of the Office Action. First, it appears that a new search was not necessitated with the amendments to the claims in the previous response. Second, the Office Action cites the same prior art (US 2003/0229529 A1) as the previous Office Action.

The Applicant filed a Power of Attorney on September 9, 2004, in which all correspondence should be addressed to Banner & Witcoff, Ltd.

The Applicant thanks the Examiner for withdrawing objections to claim 8 and the specification. The Applicant also thanks the Examiner for withdrawing rejections of claims 5 and 12 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

#### **Claim Rejections - 35 USC §102**

Claims 1-14 are rejected by the Office Action under 35 U.S.C. 102(e) as being anticipated by US 2003/0229529 A1 (Mui). Regarding claim 1, the Office Action states, "The Examiner asserts that these teachings address the limitation, 'wherein said data to assist the business entity in strategic plans development comprises reports including recommendations to increase the business entity's performance relative to **specific** metrics.'" (Page 1, item 3. Emphasis added.) However, the Applicant previously amended claim 1 to include the feature "wherein said data to assist the business entity in strategic plans development comprises reports including recommendations to increase the business entity's performance relative to **specified** metrics". (Emphasis added.) The Office Action has replaced "specified metrics" with "specific metrics". Claim 1, as previously amended, is not anticipated by Mui because Mui does not teach or even suggest this feature. The Office Action alleges (Page 3-4, item 3.):

Reports regarding "Learning Recommendations" (#2310) and "People Expert Recommendations" (#2320) are provided in relation to "Competency Gap Recommendations" (i.e., business metrics), as shown in Figure 23. The

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corresponding excerpts in the specification explain that these recommendations are attached for future reference by other users of the system in search of business-related recommendations (see at least ¶¶ 1271-1272). The Examiner asserts that these teachings address the limitation, "wherein said data to assist the business entity in strategic plans development comprises reports including recommendations to increase the business entity's performance relative to **specific metrics**."

As previously discussed in the response to the Office Action dated January 20, 2004 (Paper No. 10), the amendment of claim 1 is supported at least by paragraph [0057] of the specification as originally filed. For example, the specification discloses in paragraph 57 (Emphasis added.):

As indicated in the example above, applicants invention would be used at these points to assist in developing the datastore, collecting the data, defining the relevant business metrics, monitoring the customer trials (including the related people actions, skills and expected versus actual performances) and business results compared to the **specified metrics**.

Moreover, the specification further discloses (Paragraph 109. Emphasis added.):

First Planning Session: During this session, meeting participants begin to develop (or refine) a Business Case for their project. Following a review of industry targets, **metrics are selected** pertaining to financial, operational, and customer goals (these metrics eventually will be integrated into the project scorecard).

While it appears that a "competency gap" may be a specific metric, a "competency gap" is not a specified metric. A "competency gap" is merely "the measurement of the difference between two Competency Levels, one of which may be a Competency Proficiency and the other may be a Required Competency." (Mui, paragraph 1265.)

Similarly, the Applicant previously amended claims 6, 7, 8, 13, and 14. For at least the above reasons, claims 6, 7, 8, 13, and 14 are not anticipated by Mui. Moreover, claims 2-5 and 9-12 ultimately depend from claims 1 and 8 and are not anticipated by Mui for at least the above reasons. Thus, the Applicant requests reconsideration of claims 1-14.

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The Applicant is adding claim 15, which is supported by the specification as originally filed.

All objections and rejections have been addressed. Hence, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is earnestly solicited.

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Respectfully submitted,



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